REMARKS

Statement of Common Ownership

A statement of common ownership is attached with this reply on a separate page.

At the time the current invention was made in the present application, the subject matter of Serial No.10/587,731 and the subject matter of International Patent Publication Number WO2004/011537 A1 to Copper et al were owned by the same entity or subject to an obligation of assignment to the same entity.

Double Patenting

Claims 1, 2, 5-9 and 12-15 were provisionally rejected under 35 USC §101 as claiming the same invention as that of claims 1,2, 8-12 and 18-21 of copending Application No. 10/587,732 (hereinafter '732). Applicants respectfully submit for the reasons set forth below that the claims recited in the two applications are not drawn to the same subject matter and thus do not meet the standards required for statutory double patenting as stated in MPEP§804.

Relevant facts

Claim 1 of the two applications are parsed and compared in the table below. Elements which are different are highlighted in bold.

Claim 1	Current Application	Application No. 10/587,732
Preamble	A porous body which is soluble or dispersible in aqueous media comprising a three dimensional oil and water emulsion-templated open-cell lattice	Water dispersible or water soluble porous bodies comprising a three dimensional oil and water emulsion templated open-cell lattice
Element a)	**10 to 95%** by weight of a polymeric material which is soluble in water	**less than 10%** by weight of water-soluble polymeric material other than a surfactant
Element b)	**less than 5%** by weight of a surfactant	**5 to 95%** by weight of a surfactant
Element c)	a hydrophobic material to be dispersed when the water soluble polymer dissolves	a hydrophobic material to be dispersed when the water-soluble polymeric material dissolves
Further Limitations	said porous bodies have an intrusion volume as measured by mercury porosimetry of at least about 3 ml/g, and with the proviso that said porous bodies are not spherical beads having an average bead diameter of 0.2 to 5mm.	said porous bodies having an intrusion volume as measured by mercury porosimetry of at least about 3 ml/g, with the proviso that they are not spherical beads having an average bead diameter of 0.2-5.0 mm.

Although both inventions relate to porous bodies in the form of non-spherical beads, the compositions of the beads do not over-lap with respect to the level of water soluble polymeric material and surfactant.

'732 limits the water soluble polymer to less than 10% and the surfactant level to 5 to 95% while the current application requires that the polymer be present at 10% to 95% (i.e. at least 10%) and the surfactant level be less than 5%.

Applicants' Argument

According to MPEP §804 II. Requirements of a double patenting response,

"A rejection based on double patenting of the "same invention" type finds its support in the language of **35 U.S.C. 101** which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ...." Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). " [Emphasis added]

As demonstrated above, the current application and copending application are drawn to different and non-overlapping subject mater with respect to two key limitation: polymer composition and surfactant composition. Since the inventions are not the same under 35USC §101 applicants respectfully submit that a statutory double

patenting rejection over copending Application No. 10/587,732 is improper and should be withdrawn.

Claims 1-15 were provisionally rejected on the grounds on nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 9-13 and 18-22 of copending Application No. 10/587,732 (hereinafter '732).

Although applicants' submit for the reasons set forth below that the current application is not obvious over '732, applicants nevertheless herewith provide a terminal disclaimer over the aforementioned copending Application No. 10/587,732 in order to facilitate prosecution.

For a reference to be rendered obvious under USC §103(a) by a prior art reference , "The prior art reference, or combination of references, must teach or suggest all of the claim limitations (MPEP §2143). In addition to providing at least a suggestion of all the claim limitations, both the suggestion and the reasonable expectation of success must be found in the prior art references, not in Appellant's disclosure" (See In re Vaeck, 20 U.S.PQ.2d 1438, 947 F.2d 448 (Fed Cir. 1991)

The Examiner asserted in the latest Office action that the two applications are not patentably distinct because the instant claims and the referenced claims are directed to the same subject matter. Applicants respectfully disagree.

Although both inventions relate to porous bodies in the form of non-spherical beads, the compositions of the beads do not over-lap with respect to the level of water soluble polymeric material and surfactant.

'732 limits the water soluble polymer to less than 10% and the surfactant level to 5 to 95% (at least 5%) while the current application requires that the polymer be present at 10% to 95% (i.e. at least 10%) and the surfactant level be less than 5%.

Thus, '732 does not disclose or suggest all of the claim limitations recited in the claims of the current application. Furthermore, a person having ordinary skill in the art would not have been motivated to modify '732 so as to arrive at the current invention because '732 expressly teaches that the polymer be present at less than 10% and the surfactant level be 5% or greater. Furthermore, the modification would have made the '732 invention inoperative for its intended purpose.

Claims 8-14 were provisionally rejected on the grounds on nonstatutory obviousness-type double patenting as being unpatentable over claims 8, 9 and 14-18 of copending Application No. 10/587,722.

Applicants herewith provide a terminal disclaimer over the aforementioned copending Application No. 10/587,722. The terminal disclaimer is believed to obviate this rejection. Applicants make no admission as to whether the current invention is in fact actually rendered obvious by copending Application No. 10/587,722.

Claims 8-14 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-13 and 18-21 of copending Application No. 10/587,734.

Applicants herewith provide a terminal disclaimer over the aforementioned copending Application No. 10/587,734. The terminal disclaimer is believed to obviate this rejection. Applicants make no admission as to whether the current invention is in fact actually rendered obvious by copending Application No. 10/587,734.

Claim Rejections – 35 USC §102/103

Claims 1-15 were rejected under 35 USC 102 (a) as being anticipated by or in the alternative, under 103(a) as obvious over Cooper et al (WO 2004/011537). Applicants respectfully request the Examiner to reconsider and withdraw this rejection in view of the following remarks.

Regarding the 102(a) rejection

Applicants' respectfully submit that the rejection of the current application under **102(a)** is improper for the reasons set forth below.

MPEP §7.06.02(a) II c. states

"For **35 U.S.C. 102(a)** to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work." (emphasis added)

The prior art reference cited by the Examiner does not meet the above requirements for a 102(a) prior art reference.

Firstly, the date of publication WO2004/011537 is February 5, 2004 while the priority date of the present application is January 28, 2004. Thus, the publication date of the cited reference is after the effective filing date of the application not before.

Secondly, the only named inventors of WO2004/011537 are Ian Cooper and Haifei Zhang who are both named inventors of the current application and thus WO2004/011537 represents the applicants' own work not the work of another.

Thus, applicants respectfully submit that WO2004/011537 does not meet the requirements for rejection under 102(a) and should be withdrawn.

Applicants make no admission about the actual subject matter in WO2004/011537 visa a vie the current application.

Regarding the 103(a) rejection

Since the subject matter of claims 1-15 does not qualify for rejection under 102(a) as discussed above it can only qualify under 102(e) from the standpoint of time events only.

Applicants' respectfully point out that 102(e) requires that the prior art reference be "**by another**". As applicants have pointed out above, the only named inventors of WO2004/011537 are Ian Cooper and Haifei Zhang who are also named inventors of the current application. Thus, WO2004/011537 does not represents work done by "another". Consequently, WO2004/011537 does not qualify as a 102(e) reference.

Furthermore, in view of the statement of *Common Ownership*, WO2004/011537 is also disqualified as a prior art reference under 35 USC §103(c). Applicants therefore respectfully request that the 103(a) rejection be withdrawn.

In view of the foregoing remarks, terminal disclaimer and Statement of Common Ownership, applicants respectfully request that the application be allowed to issue.

Attorney Docket No.: T3126(C)
Serial No.: 10/587,731
Filed: May 17, 2007
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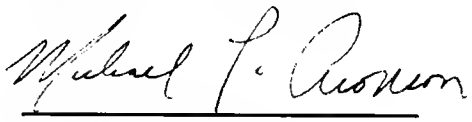
If a telephone conversation would be of assistance, Applicant's undersigned agent invites the Examiner to telephone at the number provided.

Respectfully submitted,



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